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Motoji Ohmori

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WENDEROTH, LIND & PONACK, L.L.P.

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EXAMINER

SHIN, MIN

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/690,547	Applicant(s) OHMORI ET AL.	
	Examiner Min Shin	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-22, 24-26 and 28-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-22, 24-26 and 28-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the amendment filed on 8/22/08. Applicant cancels claims 16, 23, and 27 and amends Claims 1-15, 17-22, 24-26 and 28-37. Thus, Claims 1-15, 17-22, 24-26 and 28-37 are currently pending and have been considered below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 7-9, 13-19, 23, 26, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Long (US Published Patent Application Number 2002/0007310).

Claim 1 and 7:

Long discloses an information distribution system for distributing information from an information provider to a user, comprising: an information distribution device for distributing commodity information that serves as an advertisement for a commodity;

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a communication terminal for receiving the commodity information, and outputting the received commodity information to a memory card (see Figure 1 and paragraph [0101]); and

the memory card being is portable and mounted on said communication terminal, wherein the memory card is provided to the user at a cost borne at least partly by the information provider, and includes: a storage unit having a storage area for commodity information (see paragraphs, [0002], [0025] and [0101]);

a judging unit operable to judge whether the received commodity information was issued from the information provider that bears the cost of the memory card at least partially; and

a writing unit operable, only if the judgment is affirmative, to write the received commodity information to the commodity information storage area for a purpose of displaying to the user (see paragraphs [0102] and [0103]).

Claim 2 and 8:

Long discloses the information distribution according to claim 1 and 7 as described above and further discloses wherein the memory card outputs the received commodity information to the communication terminal if the judgment is affirmative, and the communication terminal receives the commodity information from the memory card and displays the received commodity information (see paragraphs [0102] and [0103]).

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Claim 9:

Long discloses the memory card according to claim 8 as described above and further discloses wherein the commodity information includes a first provider ID identifying an information provider that issued the commodity information, the receiving unit receives the commodity information that includes the first provider ID, the judging unit prestores a second provider ID identifying the specific information provider, extracts the first provider ID from the received commodity information, and judges whether the received commodity information was issued from the specific information provider, by matching the first provider ID against the second provider ID, and the writing unit writes the received commodity information to the commodity information storage area if the first and second provider IDs match (see paragraph [0102]). Although, Long does not explicitly disclose matching IDs of the received advertisements in order to display them, it should be known that any computer system capable of transmitting, storing and displaying a selected set of information inherently verifies the source of information by an identification method.

Claim 13, 14 and 15:

Long discloses the memory card according to claim 8 as described above and further discloses wherein the receiving unit receives the commodity information that includes a priority rank assigned thereto, the commodity information storage area stores commodity information that includes a priority rank assigned thereto, the writing unit writes, when enough free space is not left in the commodity information storage area,

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the received commodity information by overwriting previously stored commodity information that is lowest in priority rank and overwriting previously stored commodity information having an earliest receiving time (see paragraph [0126]. Examiner is interpreting the bidding process which results in ranking of the bid advertisements). Though not explicitly disclosed by Long, computer systems must inherently overwrite information on a memory medium when not enough space is available.

Claim 17:

Long discloses a memory card provided to a user for storing information transmitted from an information provider to the user, the memory card being portable and mounted on a communication terminal, comprising:

a storage unit having a storage area for commodity information issued from a specific information provider (see Figure 1 and paragraph [0101]);

a first receiving unit operable to receive provider information from an information distribution device via the communication terminal, the provider information showing an information provider that issued commodity information to be received (see paragraph [112]);

a judging unit operable to judge based on the received provider information, whether the commodity information was issued from the specific information provider (see paragraphs [0102] and [0103]);

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a second receiving unit operable to receive the commodity information from the information distribution device via the communication terminal if the judgment is affirmative; and

a writing unit operable to write the received commodity information to the commodity information storage area (see paragraphs [0102] and [0112]).

Claim 18:

Long discloses the memory card according to claim 17 as described as above and further discloses wherein the memory card outputs, if the judgment is affirmative and thus receives the commodity information, the received commodity information to the communication terminal, and the communication terminal receives and displays the commodity information (see paragraph [0112]).

Claim 19:

Long discloses the memory card according to claim 18 as described above and further discloses wherein the commodity information is associated with a first provider ID identifying an information provider that issued the commodity information, the first receiving unit receives the first provider ID as the provider information, the judging unit judges whether the received first provider ID matches a second provider ID that identifies the specific information provider, and the second receiving unit receives the commodity information if the first and second provider IDs match (see paragraph [0102]).

Claim 26:

Long discloses an information distribution device for distributing information issued from an information provider to a user, comprising: a transmitting unit operable to transmit, via a communication terminal, commodity information issued from the information provider to a memory card that is provided to the user (see paragraphs [0102] and [0112]).

Claims 32, 33 and 34,

Long discloses a program, a method and a computer readable medium for storing information distributed from an information provider, wherein the memory card is portable and mounted on a communication terminal, and is provided to the user, and the memory card includes a storage unit having a storage area for commodity information issued from a specific information provider, the program comprising:

a receiving step of receiving commodity information from an information distribution device via the communication terminal (see paragraph [0112]);

a judging step of judging whether the received commodity information was issued from the specific information provider; and a writing step of writing, if the judgment is affirmative, the received commodity information to the commodity information storage area for a purpose of displaying to the user (see paragraphs [0102] and [0103]).

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Claims 35, 36 and 37:

Long discloses a program, a method and a computer readable medium for a memory card used by a memory card for storing information distributed from an information provider, wherein the memory card is portable and mounted on a communication terminal, and is provided to the user, and the memory card includes a storage unit having a storage area for storing commodity information issued from a specific information provider, the program comprising:

a first receiving step of receiving provider information from an information distribution device via the communication terminal, the provider information showing an information provider that issued commodity information to be received (see paragraph [0112]);

a judging step of judging, based on the received provider information, whether the commodity information was issued from the specific information provider (see paragraphs [0102] and [0103]);

a second receiving step of receiving the commodity information from the information distribution device via the communication terminal if the judgment is affirmative (see paragraph [0112]); and

a writing step of writing the received commodity information to the commodity information storage area (see paragraph [0102]).

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5. Claims 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Hung (US Pat Number 7,257,545).

Claims 30 and 31:

Hung discloses a payment settlement device for settling a payment on a commodity, comprising: a storage unit operable to prestore a first provider ID that identifies an information provider that issues coupon information showing a discount to be made on the commodity; a receiving unit operable to receive via a communication terminal from a memory card used by the user, coupon information including a second provider ID that identifies an information provider that issued the received coupon information (see Figures 2A-2C; column 6, lines 7-24);

a judging unit operable to judge whether the second provider ID matches the first provider ID; and a discount unit operable to make a discount shown by the received coupon information if the first and second provider IDs match (see column 6, lines 25-45);

wherein the coupon information is transmitted from an information distribution device to the memory card via the communication terminal, the discount unit regularly transmits discount-indicate information to the information distribution device, the discount-indicate information indicating that the discount shown by the coupon information has been made, the receiving unit securely receives an electronic ticket that is generated by the information distribution device for a monetary value based on the

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discount-indicate information, and the storage unit stores the received electronic ticket (see Figures 2A-2C; column 6, lines 7-24).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 4, 11, 25, 27, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US Published Patent Application Number 2002/0007310) in view of Hung (US Pat Number 7,257,545).

Claims 3, 4, 11, and 28:

Long discloses the information distribution system and memory card according to claims 2, 7 and 26 as described above but does not explicitly disclose receiving a write-indicate information and generating an electronic having a monetary value (the examiner is interpreting it as a form of a coupon). However, Hung discloses a similar system wherein the writing unit outputs write-indicate information to the communication terminal if the judgment is affirmative, the write-indicate information indicating that the commodity information has been written, the communication terminal transmits the

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received write-indicate information to the information distribution device, the information distribution device receives the write-indicate information, generates an electronic ticket having a monetary value based on the received write-indicate information, and securely transmits the generated electronic ticket to the memory card via the communication terminal, and the writing unit writes the received electronic ticket to the storage unit; and the information distribution system further comprising a payment settlement device for receiving the coupon information from the memory card via the communication terminal and making a discount on the commodity based on the received coupon information (see Figures 2A-2C; column 6, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention for Long to receive and store the electronic ticket having a monetary value in addition to receiving the advertisements to give the consumers and additional incentive to utilize the device.

Claim 25:

Long discloses a memory card for storing information distributed from an information provider to a user, the memory card being portable and mounted on a communication terminal, comprising: a storage unit having a storage area for commodity information issued from the information provider but does not disclose a storage area for an electronic ticket. However, Hung discloses a similar system having a storage area for an electronic ticket having a monetary value (see Hung, Figures 2A-2C; column 6, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention for Long to receive and store the electronic ticket having a

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monetary value in addition to receiving the advertisements to give the consumers and additional incentive to utilize the device.

Long further discloses a first transmitting-receiving unit operable to receive a first provider ID identifying the information provider from the information distribution device via the communication terminal;

a first writing unit operable to write the received first provider ID to the commodity information storage area; a second transmitting-receiving unit operable to receive from the information distribution device via the communication terminal, commodity information that includes a second provider ID identifying information provider that issued commodity information to be received (see paragraphs [0102] and [0111]); a judging unit operable to judge whether the second provider ID matches the first provider ID; a second writing unit operable, if the first and second provider IDs match, to receive the commodity information and write the received commodity information to the commodity information storage area for a purpose of displaying to the user (see paragraphs [0102] and [0111]. Again, although Long does not explicitly disclose matching IDs of the received advertisements in order to display them, it should be known that any computer system capable of transmitting, storing and displaying a selected set of information will verify the source of information by an identification method).

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Claim 29:

Long and Hung disclose the information distribution device according to claim 26 as described above but Long does not disclose the device receiving discount-indicated information and generating an electronic ticket for a monetary value. However, Hung discloses a similar device wherein the information distribution device receives discount-indicate information from a payment settlement device and generates an electronic ticket for a monetary value based on the received discount-indicate information, the discount-indicate information indicating that the payment settlement device has made the discount shown by the coupon information, and the transmitting unit securely transmits the electronic ticket to the memory card via the communication terminal. It would have been obvious to a person of ordinary skill in the art at the time of the invention for Long to generate an electronic ticket based on discount-indicate information having a monetary value to give the consumers and additional incentive to utilize the device (encouraging them to purchase the discounted commodity item).

8. Claims 5, 6, 12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long (US Published Patent Application Number 2002/0007310) in view of Coffin (US Patent Published Application Number 2003/0172376).

Claims 5, 6, 12 and 24:

Long discloses the information distribution system and memory card according to claim 2 and 7 as described above but does not disclose leasing the memory card and

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transmitting the electronic ticket having a monetary value to the information provider to offset the cost of the information distribution device. However, Coffin discloses a similar system wherein the memory card is provided to the user on a lease in return for regular payments of a lease fee to the information provider, the storage unit stores an electronic ticket having a monetary value, and the memory card securely transmits, on a regular basis, an electronic ticket having a monetary value equivalent to the lease fee to the information distribution device via the communication terminal, and deducts the transmitted monetary value from the electronic ticket stored in the storage unit. In addition, Coffin discloses the system of reducing the lease fee based on the outputting of the commodity information through the display device (see Coffin, paragraphs [0061], [0085] and [0087]). It would have been obvious to a person of ordinary skill in the art at the time of the invention for Long to incorporate the system of having an electronic ticket for deducting the cost of the device in order to keep track of the advertisements viewed and to encourage the users to view more advertisements for additional discounts on the lease device.

9. Claims 10, 20, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long (US Published Patent Application Number 2002/0007310) in view of Krishan et al (US Patent Number 6,442,529)

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Claim 10, 20, 21 and 22:

Long discloses the memory card according to claims 8 and 17 as described above but does not disclose verifying validity of the transmitted information through digital keys. However Krishan discloses a similar method wherein the judging unit prestores a public key of the specific information provider, the information distribution device prestores a secret key of the specific information provider, generates digital signature data from the commodity information using the secret key, and transmits the generated digital signature data, the judging unit receives the digital signature data via the communication terminal, and verifies validity of the digital signature data using the public key to judge whether the commodity information was issued from the specific information provider, and the writing unit writes the received commodity information to the commodity information storage area if the verification is successful (see column 9, lines 23-47). It would have been obvious to a person of ordinary skill in the art at the time of the invention for Long to incorporate the digital keys (public/secret) in order to easily and securely verify the advertisement that is being displayed to the user is that of the sponsor who is subsidizing the device. In addition the examiner notes that using randomly generated digital keys (or cipher texts) to securely transmit and receive information through communication terminals was well known in the art at the time of the invention.

Response to Arguments

10. Claim 1-15, 17-22, 24-25, 26-32 and 34: The applicant's claims rely on the intended use of the claim features. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. For example, the memory card recited in the claims is a memory card regardless how it is used or provided. Claims scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP 2111.04). The applicant claims a system, a device and a memory card which should be limited by their structure, not by the steps they perform. As discussed in the phone conversation, the applicant is advised to rewrite the claims to disclose the *steps or methods* of the claimed invention to better overcome the prior art rejection and to facilitate the prosecution.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Shin whose telephone number is (571) 270-3463. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Myhre can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS
12/6/2008

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688